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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/970,535  | 10/03/2001  | Robert L. Parker     | 42390P9334          | 1378             |
| 8791  | 7590        | 09/03/2004           | EXAMINER            |                  |
| BLAKELY SOKOLOFF TAYLOR & ZAFMAN<br>12400 WILSHIRE BOULEVARD<br>SEVENTH FLOOR<br>LOS ANGELES, CA 90025-1030 |             |                      | O#CONNOR, GERALD J  |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 3627                 |                     |                  |

DATE MAILED: 09/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--------------------------------------|
| <b>Office Action Summary</b> | Application No.<br><b>09/970,535</b> | Applicant(s)<br><b>Parker et al.</b> |
|                              | Examiner<br><b>O'Connor</b>          | Art Unit<br><b>3627</b>              |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1)  Responsive to communication(s) filed on March 5, 2004 (Amdt "A")

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

4)  Claim(s) 11-17 is/are pending in the application.

4a) Of the above, claim(s) none is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 11-17 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on March 5, 2004 is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on March 5, 2004 (Paper № 5) in reply to the Office action mailed December 24, 2003.
  
2. The cancellation of claims 1-10, amendment of claims 11 and 14, and addition of claim 17 by applicant in Paper № 5 are all hereby acknowledged.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e)<sup>1</sup> the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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<sup>1</sup> The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lunetta et al. (US 2001/0031102).

Lunetta et al. disclose a method comprising: providing a first image of an article of merchandise available to a consumer in an electronic commerce transaction; projecting a second image onto the first image of the article of merchandise to produce a third image representing the article of merchandise as personalized by the second image; and, providing the third image for display to the consumer to facilitate an electronic commerce transaction.

Regarding claims 12 and 15, the method of Lunetta et al. includes the step of accepting an order from the consumer to purchase the article of merchandise as personalized by the second image.

Regarding claims 13 and 16, the method of Lunetta et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized with the second image.

5. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by von Rosen et al. (US 6,493,677).

Von Rosen et al. disclose a method comprising: providing a first image of an article of merchandise available to a consumer in an electronic commerce transaction; projecting a second

image onto the first image of the article of merchandise to produce a third image representing the article of merchandise as personalized by the second image; and, providing the third image for display to the consumer to facilitate an electronic commerce transaction.

Regarding claims 12 and 15, the method of von Rosen et al. includes the step of accepting an order from the consumer to purchase the article of merchandise as personalized by the second image.

Regarding claims 13 and 16, the method of von Rosen et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized with the second image.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lunetta et al. (US 2001/0031102), in view of Garfinkle et al. (US 6,017,157).

Lunetta et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction, as applied above in the rejection of claim 11, and the method of Lunetta et al. includes the merchant accepting an order from the consumer to purchase the

personalized item displayed in the composite image, but Lunetta et al. do not disclose selling the image itself, they provide the image for free as a means to entice the consumer to purchase the item depicted in the image.

However, Garfinkle et al. disclose a similar method of e-commerce, wherein the item being ordered by the consumer from the merchant is indeed an image.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lunetta et al. so as to include images in the list of customized items for sale, in accordance with the teachings of Garfinkle et al., in order to earn additional profits from greater sales volume by offering and selling a larger selection of customizable items.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Rosen et al. (US 6,493,677), in view of Garfinkle et al. (US 6,017,157).

Von Rosen et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction, as applied above in the rejection of claim 11, and the method of von Rosen et al. includes the merchant accepting an order from the consumer to purchase the personalized item displayed in the composite image, but von Rosen et al. do not disclose selling the image itself, they provide the image for free as a means to entice the consumer to purchase the item shown in the image.

However, Garfinkle et al. disclose a similar method of e-commerce, wherein the item being ordered by the consumer from the merchant is indeed an image.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen et al. so as to include images in the list of customized items for sale, in accordance with the teachings of Garfinkle et al., in order to earn additional profits from greater sales volume by offering and selling a larger selection of customizable items.

***Response to Arguments***

9. Applicant's arguments filed March 5, 2004 have been fully considered but they are not persuasive.

10. Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "that the consumer can interactively create the personalized content in real-time using a content creation application program provided by the server (e.g., as a web-accessible tool on the server's web site).") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Regarding the argument that because an invention is not “anticipated” by the prior art under 35 U.S.C. 102, it is therefore patentable, applicant’s attention is directed to 35 U.S.C. 103, quoted hereinabove, which requires that, to be patentable, an invention must not only be unanticipated by the prior art, but must also be considered non-obvious, in light of the prior art.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Applicant’s amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC



August 30, 2004



9/1/04

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